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10/812,451

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J. Mark Morrow

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BANK OF AMERICA PLAZA

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EXAMINER

THAKUR, VIREN A

ART UNIT

PAPER NUMBER

1761

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/812,451             | MORROW, J. MARK     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Viren Thakur           | 1761                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. The rejection of claims 24 and 26 under 35 U.S.C. 112, second paragraph has been withdrawn.
2. As a result of the amendment to instant claim 1 to add complementary locking features, the rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Tupper (US 2766796) has been withdrawn.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. **Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Instant claim 1 recites the limitation "the cup holder being readily removable from the primary container such that the package can be converted into..." It is not clear as to where in the specification support has been provided for this limitation. The specification provides support for removing the cup holder and placing the primary container within the cup holder but the above limitation of being readily removable was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), as the time the application was filed, had possession of the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Instant claim 1 recites the limitation "readily removable." The limitation readily removable does not define the metes and bounds of the claim. The ability of the cup holder to be readily removable also depends on the ability of the person using the package. What can be considered readily removable to one person can be difficult to remove to another person.

Instant claim 3 recites the limitation "the locking features" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-10, 14-17, 19-21 and 24 remain rejected under 35 U.S.C. 102(b) as being anticipated by Muraoka (US 4018904).**

Applicant's arguments on page 8 that Muraoka's inner receptacle is not readily removable from the outer receptacle has been considered but is not persuasive. The Examiner asserts that being readily removable is subjective to the user that removes the inner cup holder from the package. As stated above, what can be considered readily removable to one person can be considered difficult to remove to another person. Additionally, since the inner receptacle of Muraoka is snugly fit into the outer receptacle, the Examiner asserts that the inner receptacle is capable of being removed for reversible nesting.

Applicant's arguments that Muraoka's package would not allow for the outer receptacle to correspond to the locking feature limitation has been fully considered but is not deemed persuasive. The Examiner asserts that on column

3, lines 24-30, Muraoka states that in one embodiment the inner receptacle can have uniform corrugation. In Figures 4-6 Muraoka does not show this corrugation feature and thus is not limited to a corrugated feature on the inner receptacle. Therefore, the inner receptacle is still capable of being inverted and locking in a complementary fashion. The Examiner further asserts that since the inner container and outer container are snugly fit to maintain the packaged configuration the friction between the walls of the inner and outer receptacles further provides complementary locking. When inverted, the inner and outer receptacles still provides complementary locking, since there would be a friction between the same walls in the inverted configuration.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**11. Claims 11, 12, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904) in view of Syverson et al. (US 3227273).**

The rejection and references are taken as cited in the prior Office Action, mailed, December 13, 2006.

Regarding instant claim 27, Muraoka teaches as cited in the prior Office Action, mailed December 13, 2006. Muraoka also teaches wherein the synthetic resin used to form the cups should not be deformable by hot water (Column 2, Lines 33-36). The examiner also notes that Muraoka teaches polystyrene as an example of a synthetic resin used to form the cups.

Syverson teaches as cited above and additionally that the dehydrated "beverages such as coffee, tea and chocolate are powdery or granular and are characterized by an attraction for moisture whereby, when exposed to the atmosphere or water vapor, they absorb the moisture to form a liquid or sticky mass." (Column 1, Lines 69 to Column 2, Line 2). Similar to Muraoka who uses a heat shrink film and a hermetically sealed covering (Figure 1, Item 4) which preserve and protect the instant food within the container, Syverson recognized the problem of requiring a moisture barrier to maintain the dry state of the beverage, and further attempted to solve the problem by using cups coated with

plastic that form a water tight seal between the two cups (Column 2, Lines 18-19), and vacuum sealing and heat shrinking a film to wrap the entire package to prevent the entry of moisture. Therefore, given the teachings of Syverson it would have been obvious to modify Muraoka as taught by Syverson to use a material for the cups that prevents moisture from entering the package. Such a modification prevents water vapor from entering the package during storage from becoming a sticky mass and becoming hardened as a result. Furthermore, using a non-deformable plastic provides motivation to one having ordinary skill in the art to use a moisture barrier material so as to prevent the heat and vapor of the hot water from absorbing into the cup so as to degrade the structure of the cup. Additionally, it would have been obvious to use a moisture barrier material for the invention of Muraoka because using a moisture absorbent material for cups that hold hot food products will result in the eventual degradation of the cup itself. If the material used for the cup absorbs moisture the user would not be able to hold a hot beverage without burning his hand.

**12. Claims 22, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904).**

Regarding instant claims 22 and 23, Muraoka is silent in teaching wherein the skirt is flared radially outwardly toward the lower end of the skirt and wherein the lower end of the skirt includes a radially outwardly projecting flange.



However, the skirt and radially extending flange at the lower end of the skirt of Muraoka perform similar functions as that of the Applicant's invention. It would have been obvious to one having ordinary skill in the art that extending skirt structures would assist the consumer in disengaging the cup holder from the outer container, since the extension of the skirt structures provides a greater area that the user can grasp the cup holder so as to remove it from its nested position; therefore changing the direction does not change the function and would not provide an inventive step over the prior art.

Regarding instant claim 25, Muraoka is silent in teaching printing of visual elements; however the invention of Muraoka discloses visual elements. Adding printed material onto the package is merely an aesthetic design change, which would not provide a patentable feature over the prior art. (See MPEP 2144.04) Nevertheless, printing visual elements to the food package of Muraoka would have been obvious for the purpose of promoting the package and making said package visually appealing to the consumer.

- 13. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muraoka (US 4018904) in view of Syverson et al. (US 3227273), as applied to claims 11, 12, 18 and 27, above, and in further view of Lucas (4134492). Sakakibara et al. (US 4348421) is cited as evidence, as discussed below.**

As discussed in the rejection of claims 11, 12, 18 and 27, Muraoka is silent in teaching wherein the food product is disposed in the primary container.

Syverson et al. teach wherein the food product is disposed within a space between an inserted cup and the primary cup (Figures 3, Item 12). The space between the insert and the primary cup stores the dry food product and protects the dry food product from moisture (Column 2, Lines 43-54). Syverson et al. further teach the package comprises an empty container (Figure 3, Item 21; Column 2, Line 71 to Column 3, Line 12) and an outer container (Figure 3, Item 10) placed underneath said empty container that holds the food product. In this way, the food product is protected by the empty container. Thus given the teachings of Syverson et al. Syverson et al. teaches it would have been obvious to one having ordinary skill in the art to position the food product between two nested cups for the purpose of protecting the food from contamination while still maintaining its freshness. Nevertheless, Muraoka also teach wherein the entire package is wrapped so as to create a hermetic seal to protect the food product and thus similarly protects the food product from moisture and contamination. Given these teachings, the position of the food product would have been a change in location for providing the equivalent function of protecting the food product, and thus would not have provided an inventive step over the prior art.

Lucas teaches a coffee cup and container comprising a beverage concentrate (Figure 1, Item 16) wherein the concentrate produces the beverage through the addition of water (Column 2, Lines 10-16). Additionally, Lucas teaches wherein the concentrate can include soups, soft drinks and any other food product that becomes consumable upon being mixed with hot or cold water.

Lucas broadly teaches the concept of using a heat sealed lining (Figure 1, Item 14) that terminates at an upper edge of the cup so as to have an opening within the packaged container. By having a sealed cup type container that still has an accessible volume would have suggested to the ordinarily skilled artisan that the container of Lucas would have permitted the nesting of a second food package therein. Nevertheless, nesting is a common storage means recognized by one having ordinary skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art to wrap the packaged container so as to leave an open volume for the purpose of stacking the packaged containers. Such a modification would have allowed for more efficient storage of the food package while still maintaining a vacuum-sealed, "fresh" food product. Furthermore, Sakakibara et al. is cited as further evidence of an inner and outer container wherein the food product is disposed within the outer container and covered by the inner container.

Regarding Applicant's arguments that Lucas would lead one to put the cup holder so that his lining could then be used to seal the food, the Examiner asserts that Lucas is relied on to broadly teach providing a sealing means that follows the path of the container. In response to applicant's arguments against Lucas, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the combination of Muraoka and

Syverson et al., teach the placement of the food and Lucas has been relied on to teach wrapping means which outline the shape of the container, thus allowing nestable packaging.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viren Thakur whose telephone number is (571)-272-6694. The examiner can normally be reached on Monday through Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571)272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Viren Thakur  
Examiner  
Art Unit: 1761



KEITH HENDRICKS  
PRIMARY EXAMINER